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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,888	08/15/2000	Kingo Suzuki	P107242-0000	4637

7590 05/11/2006  
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EXAMINER

TRINH, HOA B

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/600,888

Applicant(s)

SUZUKI ET AL.

Examiner

Vikki H. Trinh

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7,9,11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,9,11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/21/06 has been entered.

### **Claims Status**

Claims 7, 9, 11, 13-14 are pending in the present application.

### ***Claim Objections***

2. Claims 7 and 11 are objected to because of the following informalities: In claims 1 and 11, the phrase "all sides surfaces" is not correct, because the pellet in the present invention only shows three sides that have fine projections or rough surfaces. In this Office Action, the examiner treats the claims' language above as to mean three side surfaces. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 7, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. (JP 04042582 A, applicant's cited abstract) (hereinafter Shibata) in view of Brunner (5,742,098).

Shibata discloses, with respect to claim 7, a light emitting diode comprising a pellet, a major front surface 52 which is made of a GaAsP (abstract, line 8) mixed crystal, characterized in that the major front surface is a rough surface 58, 56 (abstract), lines 13-16).

However, Shibata does not explicitly state that the 3-side surfaces of the pellet are roughened on the sides.

Brunner shows an LED 2 (col. 3, lines 21-26) having 3-side surfaces roughened 5 (see drawing figure 1 and abstract).

Therefore, as to claim 7, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Shibata with the 3-side surfaces roughened, as taught by JP (4-116162), so as to increase the light emitting surfaces (Brunner col. 3, lines 21-26).

With respect to claim 9, the combined teaching of Shibata and Brunner does not explicitly state that the side surfaces of the pellet are rough with a specific range. Nevertheless, it would have been obvious to one skilled in the art at the time the invention was made to provide a

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specific range for the rough surfaces, since it is prima facie obvious to an artisan's experimentation and optimization because applicant has not yet established any criticality for the specific range.

*Normally, it is to be expected that a change in temperature, or in thickness, or in time, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely degree from the results of the prior art...such ranges are termed "critical ranges and the applicant has the burden of proving such criticality.... More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller 105 USPQ233, 255 (CCPA 19553.*

4. Claims 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata in view of Brunner, and further in view of Nishiwaki et al. (59085868) (hereinafter Nishiwaki).

Shibata and Brunner disclose the invention substantially as claimed, except that Shibata in view of Brunner does not explicitly state the etching solution with the compounds as claimed.

Nishiwaki et al. (59085868) teaching an etching agent using an etching agent such as an aqueous solution containing Br<sub>2</sub>, nitric acid, hydrofluoric acid and acetic acid or I<sub>2</sub>, nitric acid, hydrofluoric acid and acetic acid. See abstract.

Therefore, as to claim 11, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of Shibata in view of Brunner with an aqueous

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etching solution containing the claimed compounds, as taught by Nishiwaki et al. (59085868), so as to form fine projections on the major front surface of the pellet.

With respect to claim 13, the specific concentration range of the nitric acid, hydrofluoric acid, and acetic acid in the etching solution would have been obvious to one skilled in the art at the time the invention was made to provide a specific range of concentration, since it is prima facie obvious to an artisan for routine experimentation and optimization to create a specific range for the concentration because applicant has not yet established any criticality for the specific range.

*Normally, it is to be expected that a change in temperature, or in thickness, or in time, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely degree from the results of the prior art...such ranges are termed "critical ranges and the applicant has the burden of proving such criticality.... More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller 105 USPQ233, 255 (CCPA 19553).*

With respect to claim 14, the combined teaching of Shibata in view of Brunner and further in view of Nishiwaki does not explicitly state that the surfaces of the pellet are roughened with fine projections having a specific range. Nevertheless, it would have been obvious to one skilled in the art at the time the invention was made to provide a specific range for the rough surfaces, since it is prima facie obvious to an artisan's experimentation and optimization because applicant has not yet established any criticality for the specific range.

*Normally, it is to be expected that a change in temperature, or in thickness, or in time, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely degree from the results of the prior art...such ranges are termed "critical ranges and the applicant has the burden of proving such criticality.... More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller 105 USPQ233, 255 (CCPA 19553.*

### ***Response to Arguments***

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Vikki Trinh whose telephone number is (571) 272-1719. The Examiner can normally be reached from Monday-Friday, 9:00 AM - 5:30 PM Eastern Time. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Wael Fahmy, can be reached at (571) 272-1705. The office fax number is 703-872-9306.

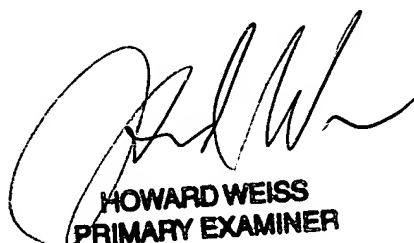
Any request for information regarding to the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Also, status information for published applications may be obtained from either Private PAIR or Public Pair. In addition,

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status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspro.gov>. If you have questions pertaining to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Lastly, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions as of June 2004. Paper copies of foreign patents and non-patent literature will continue to be included with office actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.

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PRIMARY EXAMINER